APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/545,381	04/07/2000	Craig Spielmann	JPM-001	2456

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EXAMINER
VAN DOREN, BETH

ART UNIT	PAPER NUMBER
3623	

DATE MAILED: 02/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

		Application No.	Applicant(s)
Office Action Summary		09/545,381	SPIELMANN ET AL.
		Examiner	**Art Unit**
		Beth Van Doren	3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>09 December 2004</u>.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1-18* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1-18* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1.   A request for continued examination under 37 CFR 1.114, including the fee set forth in

37 CFR 1.17(e), was filed in this application after final rejection. Since this application is

eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e)

has been timely paid, the finality of the previous Office action has been withdrawn pursuant to

37 CFR 1.114. Applicant's submission filed on 12/09/2004 has been entered.

2.   The following is a non-final office action in response to the request for continued

examination received on 12/09/2004. Claims 1, 10, 14, and 16 have been amended. Claims 1-18

are now pending in this Application.

Response to Amendment

3.   Applicant's amendments to claims 10 and 14 are sufficient to overcome the claim

objections set forth in the previous office action.

Claim Rejections - 35 USC § 102

4.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United
> States before the invention thereof by the applicant for patent, or on an international application by another who
> has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention
> thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999

(AIPA) do not apply to the examination of this application as the application being examined

was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C.

122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment

by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4.   Claims 1-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Ibarra (U.S.

6,119,097).

5.   As per claim 1, Ibarra teaches a method for determining compliance with organizational

business policies associated with a business risk, said method comprising:

    a.   the computer receiving a user selection of business risk elements, said business

risk elements being retrieved from a database coupled to said computer (See column 4,

lines 15-45, column 6, lines 1-5 and 15-25, and column 10, lines 3-25, wherein the

computer receives a user selection of business risk elements associated with employees

and employee turnover);

    b.   for each business risk element, the computer retrieving one or more

predetermined control procedures, the control procedures identified by an administrator

as a means for complying with business policies associated with said risk element (See

column 2, lines 35-65, column 3, lines 1-15, column 4, lines 15-22 and 40-50, column 8,

lines 50-67, and column 9, lines 1-5, which discuss compliance procedures associated

with elements of the business and job with which the employees must comply);

    c.   the computer associating said one or more predetermined control procedures with

said business risk element, said predetermined control procedures being stored in said

database (See column 2, lines 35-65, column 3, lines 1-10, column 4, lines 15-22 and 40-

65, column 6, lines 1-20, where the control procedures (i.e. activities, items) are

associated with a specific element (i.e. category));

d.   the computer retrieving a weight assigned to each one of said predetermined

control procedures, said weight being stored in said database (See at least column 5, lines

1-10, column 9, lines 1-15, which discloses weights being associated with the procedures.

The control procedures receive equal weighting in the disclosed embodiment. Ibarra also

discusses the minimum acceptable, expected, and outstanding score levels associated

with compliance, and using these scores to measure the performance of the employee

with respect to a control procedure);

e.   the computer receiving a user selection of a compliance rating for each said

predetermined control procedure, the rating selected by the user indicating a level of

compliance with each one of said predetermined control procedures, for each of said

predetermined control procedures the level of compliance is selected from a rigid set of

compliance ratings, the same set of compliance ratings is available for each of said

predetermined control procedures (See figure 6 and column 2, lines 50-65, column 3,

lines 1-15, column 5, lines 1-11, column 6, lines 53-60, column 8, lines 45-67, column 9,

lines 1-20, wherein Ibarra discloses tracking an employees compliance with objective

activities within the business so as to improve employee performance and reduce the

risks of turnovers. Compliance ratings are selected from the rigid set of not applicable,

outstanding, below average, etc.); and

f.   the computer calculating a compliance score, each compliance score being a

function of said assigned weights and said compliance rating of said predetermined

control procedures (See column 2, lines 50-65, column 3, lines 1-15, column 5, lines 1-

11, column 6, lines 53-60, column 8, lines 45-67, column 9, lines 1-20, wherein the

computer calculates a compliance rating. The computer considers the equal weights

when determining the average and also considers the three compliance score levels when

determining the compliance rating).

6.   As per claim 2, Ibarra teaches a method wherein said compliance ratings comprise at

least one rating identifying a non-fully compliant control procedure, said method further

comprising the steps of:

> a.   for each said control procedure having a non-fully compliant rating, the computer
>
> receiving a user generated signal indicating whether said non-fully compliant control
>
> procedure is accepted or not accepted (See column 4, lines 50-65, column 5, lines 1-25
>
> and 35-40, column 6, lines 50-67, column 7, lines 1-13 and 30-50, wherein noncompliant
>
> control procedures are indicated as not accepted); and
>
> b.   for each of said non-fully compliant control procedure which is indicated as not
>
> accepted, requiring the user to provide signals for generating an action plan (See at least
>
> column 3, lines 1-15, column 4, lines 50-65, column 5, lines 1-30, column 6, lines 50-67,
>
> column 7, lines 1-13 and 30-50, wherein an action plan concerning the noncompliant
>
> control procedure is created by a problem solving session that generates action steps).

7.   As per claim 3, Ibarra teaches wherein said action plan includes a target date, said

method further comprising the step of the computer calculating an expected compliance score for

one or more future dates based on said action plan target dates (See at least figure 10, column 3,

lines 1-15, column 4, lines 50-65, column 5, lines 1-40, column 6, lines 50-67, column 7, lines 1-

13 and 30-50, which discloses a target date, trend data, and an expected successful score).

8.   As per claim 4, Ibarra discloses a method further comprising the step of the computer

tracking whether said expected compliance scores have been met, said tracking including

calculating actual compliance scores for said target dates (See at least figure 10, column 3, lines

1-15, column 4, lines 50-65, column 5, lines 1-30, column 7, lines 1-13 and 30-50, column 9,

lines 10-20 and 55-65, wherein the computer tracks the compliance scores associated with the

target dates for the employees).

9.   As per claim 5, Ibarra discloses a method further comprising the step of the computer

displaying said expected compliance scores versus said actual compliance for the target dates

(See figures 8-10, column 4, lines 15-22 and 40-65, column 6, lines 1-20, column 9, lines 30-65,

and column 10, lines 25-60, wherein the computer displays expected scores versus actual scores.

See in figure 8, for example, where the line is the expectation and the stars mark the

performance).

10.   As per claim 6, Ibarra teaches a method further comprising the step of the computer

associating one or more parameters with each said compliance rating (See column 2, lines 35-65,

column 3, lines 1-10, column 4, lines 15-22 and 40-65, column 6, lines 1-20, column 9, lines 30-

65, which discusses parameters associated with the ratings).

11.   As per claim 7, Ibarra teaches wherein said one or more parameters are selected from the

group comprising organization, business line, process, and region (See column 2, lines 35-65,

column 3, lines 1-10, column 4, lines 15-22 and 40-65, column 6, lines 1-20, column 9, lines 30-

65, wherein the parameters are associated with the organization and/or process).

12.   As per claim 8, Ibarra teaches a method further comprising the step of the computer

sorting said compliance scores by said one or more parameters (See column 4, lines 15-22 and

40-65, column 6, lines 1-20, column 9, lines 30-65, wherein the computer sorts the scores using

organizational parameters).

13.   As per claim 9, Ibarra discloses a method further comprising the step of the computer

displaying said sorted compliance scores (See, column 4, lines 15-22 and 40-65, column 6, lines

1-20, column 9, lines 30-65, wherein the computer displays the data).

14.   As per claim 10, Ibarra teaches a method for determining compliance with organizational

business policies associated with a business risk, said method comprising:

   a.   a computer receiving a user selection of a business risk element, said risk element

being retrieved from a database coupled to said computer (See column 4, lines 15-45,

column 6, lines 1-5 and 15-25, column 8, lines 40-65, column 9, lines 1-15, and column

10, lines 3-25, wherein the computer receives a selection of categories that are factors

that contribute to employee performance and the possibility or risk of employees not

complying with business standards. An example of a risk element is the category of "job

and technical knowledge");

   b.   the computer identifying one or more subrisk elements associated with said

business risk elements, each subrisk element being retrieved from said database (See

column 4, lines 15-45, column 6, lines 1-5 and 15-25, column 8, lines 40-65, column 9,

lines 1-15, and column 10, lines 3-25, wherein the sub-elements are retrieved. Sub-

elements are associated with elements, such as the sub-elements of "knows all aspects of

the job" and "adheres to policies and standards" associated with the element "job and

technical knowledge");

c.   for at least one subrisk element, the computer retrieving one or more

predetermined control procedures, the control procedures identified by an administrator

as a means for business policies associated with said subrisk element (See column 2, lines

35-65, column 3, lines 1-15, column 4, lines 15-22 and 40-50, column 8, lines 50-67, and

column 9, lines 1-5, which discuss compliance procedures associated with sub-elements

of the business and job with which the employees must comply);

d.   the computer associating said one or more control procedures with said subrisk

element, said control procedures being stored in said database (See column 2, lines 35-65,

column 3, lines 1-10, column 4, lines 15-22 and 40-65, column 6, lines 1-20, where the

control procedures are associated with sub elements);

e.   the computer retrieving a weight assigned to each one of said predetermined

control procedures, said weight being stored in said database (See at least column 5, lines

1-10, column 9, lines 1-15, which discloses weights being associated with the

procedures);

f.   the computer receiving a user selection of a compliance rating for each said

predetermined control procedure, each said compliance rating selected from a rigid

predetermined set of compliance ratings, the same set of compliance rating is available

for each of said predetermined control procedures including at least one rating indicating

said control procedure is not fully compliant (See figure 6 and column 2, lines 50-65,

column 3, lines 1-15, column 5, lines 1-11, column 6, lines 53-60, column 8, lines 45-67,

column 9, lines 1-20, wherein compliance ratings are selected from the rigid set of not

applicable, outstanding, below average, etc.);

g.   the computer calculating a compliance score, said compliance score being a

function of said assigned weights and said compliance rating of said control procedures

(See column 2, lines 50-65, column 3, lines 1-15, column 5, lines 1-11, column 6, lines

53-60, column 8, lines 45-67, column 9, lines 1-20, wherein the computer calculates a

compliance rating);

h.   for each subrisk, the computer determining whether at least one control procedure

associated with said subrisk is not fully compliant (See column 4, lines 50-65, column 5,

lines 1-30, column 6, lines 50-67, column 7, lines 1-13 and 30-50, wherein control

procedures are noncompliant);

i.   for each subrisk associated with at least one control procedure which is not fully

compliant, the computer receiving a signal from the user indicating whether said subrisk

should be accepted or not accepted (See column 4, lines 50-65, column 5, lines 1-25 and

35-40, column 6, lines 50-67, column 7, lines 1-13 and 30-50); and

j.   for each subrisk which is indicated as not accepted, the computer generating an

action plan (See at least column 3, lines 1-15, column 4, lines 50-65, column 5, lines 1-

30, column 6, lines 50-67, column 7, lines 1-13 and 30-50, wherein an action plan

concerning the noncompliant control procedure is created by a problem solving session

that generates action steps).

15.   Claims 11, 12, and 13 contain equivalent limitations to claims 3, 6, and 8, respectively,

and are therefore rejected using the art and rationale as applied above.

16.   Claim 14 is substantially similar to claims 1 and 2 above and is therefore rejected using

the same art and rationale as applied above. Furthermore, Ibarra discloses (g) the computer

calculating an expected compliance score for a future date, said expected compliance score being a function of said assigned weights, said fully compliant control procedures, and said action plan target dates for said non-fully complaint control procedures (See at least column 3, lines 1-15, column 4, lines 50-65, column 5, lines 1-30, column 6, lines 50-67, column 7, lines 1-13 and 30-50, which discusses target dates and trend data).

17.   As per claim 15, Ibarra teaches wherein said action plan comprises a signal indicating whether said non-fully compliant rating is accepted or not accepted, said expected compliance score further being a function of said non-fully compliant ratings which have been accepted (See at least figure 10, column 3, lines 1-15, column 4, lines 50-65, column 5, lines 1-40, column 6, lines 50-67, column 7, lines 1-13 and 30-50, which discloses creating action plans for those non-fully compliant ratings).

18.   Claim 16 is substantially similar to claim 1 above and is therefore rejected using the same art and rationale as applied above. Furthermore, Ibarra teaches a database and a processor coupled to the database (See at least figure 13, column 6, lines 1-25 and 50-60, column 9, lines 30-61, and column 10, lines 10-30 and 40-60).

19.   Claim 17 is substantially similar to claim 2 above and is therefore rejected using the same art and rationale as applied above. Furthermore, Ibarra teaches an expected compliance score and (c) the computer generating one or more future expected compliance scores, said compliance scores being a function of said target dates, said assigned weights, and said expected compliance rating of said control procedures (See at least column 3, lines 1-15, column 4, lines 50-65, column 5, lines 1-30, column 6, lines 50-67, column 7, lines 1-13 and 30-50, wherein an

expected compliance score of meeting the standard is generated based on the action plan determined. The action plan has a target date, weights, etc.).

20. As per claim 18, Ibarra teaches a data processing system further comprising a computer display coupled to said processor, said processor further being programmed to display said compliance scores on a computer display (See, column 4, lines 15-22 and 40-65, column 6, lines 1-20, column 9, lines 30-65, wherein the computer displays the data).

Response to Arguments

21. Applicant's arguments with respect to the claims have been considered but are moot in view of the new grounds of rejection, as necessitated by amendment.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Barrett et al. (U.S. 6,029,144) teaches a compliance system for comparing a business action against stored standards.

Ruffin et al. (U.S. 6,675,149) teaches prioritizing a set of objectives associated with a business, scoring these characteristics against desired information, weighting, and ranking.

Baseman et al. (U.S. 6,671,673) discloses monitoring performance measures of an enterprise to maximize revenue and minimize risk.

Canada et al. (U.S. 6,757,660) discloses evaluating the importance of characteristics in an objective assessment.

"Compliance: An exercise in Risk Management" (Compliance Action) teaches using risk as an audit tool to determine the compliance of a bank business.

PriceWaterhouseCoopers (pwcglobal.com) discloses proactive risk management including compliance risk management, strategic risk management, etc.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Beth Van Doren whose telephone number is (703) 305-3882. The examiner can normally be reached on M-F, 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (703) 305-9643. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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bvd
January 28, 2005

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